

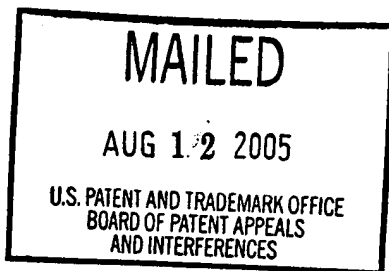
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte RANDY L. MORNINGSTAR

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Appeal No. 2005-1446  
Application No. 09/872,704

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ON BRIEF

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Before McQUADE, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, 16 and 17. Claims 20-51 and 62-88 have been withdrawn from consideration. Subsequent to the final rejection, claims 52-61 have been allowed and claims 14, 15, 18 and 19 have been objected to as depending from a non-allowed claim. No claim has been canceled.

We REVERSE.

### BACKGROUND

The appellant's invention pertains generally to an implantable microballoon and a method of making such a microballoon (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The following two rejections are before us in this appeal:

- (1) Claims 1-9, 11-13 and 16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,327,912<sup>1</sup> to Hoffman; and
- (2) Claims 10 and 17 under 35 U.S.C. § 103 as being unpatentable over Hoffman in view of U.S. Patent No. 5,720,734<sup>2</sup> to Copenhaver et al. (Copenhaver).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (mailed November 18, 2003) and the answer (mailed May 17, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed April 14, 2004) for the appellant's arguments thereagainst.

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<sup>1</sup> Issued May 4, 1982.

<sup>2</sup> Issued February 24, 1998.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art patents, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The anticipation rejection**

We will not sustain the rejection of claims 1-9, 11-13 and 16 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Claims 1 and 11, the independent claims subject to this ground of rejection, read as follows:

1. An implantable balloon comprising:
  - a valve portion having:
    - a valve body defining an inlet;
    - a valve stem extending from said body opposite said inlet;
    - a piercing extending from said inlet, through said body and stem,
  - said valve portion constructed from a soft, elastomeric material having memory thereby causing said piercing to remain closed and fluid-tight unless penetrated by a relatively rigid member;
  - a balloon portion, integral with said valve portion, constructed and arranged to receive and hold fluids exiting said piercing opposite said inlet.
  
11. A self-sealing medical balloon of unitary construction, implantable in a human body, comprising:
  - a cylindrical valve body having a predetermined diameter and an upper side and a lower side;
  - an inlet defined by said valve body lower side;
  - a cylindrical valve stem extending upwardly from said valve body, said valve stem having a diameter smaller than said valve body diameter;
  - a balloon wall adapted to receive and hold fluids, the balloon wall extending upwardly from said valve body, said balloon wall having an inner diameter, while in a deflated state, which is larger than said valve stem diameter such that an annular space exists between said balloon wall and said valve stem while said balloon is deflated, said annular space provided to relieve stress from a union of said balloon wall and said valve body when said balloon is inflated;
  - a piercing extending from said inlet, through said valve body and through said valve stem, into an inner chamber defined by said balloon, said piercing constructed and arranged to remain closed unless a substantially rigid member is pushed through said piercing, such as to inflate said balloon, whereby said piercing member recloses after said member is withdrawn, thereby preventing a fluid from escaping from said inner chamber.

Hoffman's invention is directed to a tennis ball having an integrally molded valve in the sidewalls thereof for assuring constant pressure within the ball and, therefore, constant playing characteristics. As shown in Figure 23, a tennis ball 92 is provided

with a permeable fabric covering 90 which allows air to pass therethrough and through valve 66 to the interior of ball 92. Fabric covering 90 is adhesively attached to a rubber shell 12' in the usual manner and care should be taken to prevent the adhesive from entry into the opening of valve 66. As shown in Figure 24, fabric covering 90 is provided with an indicia 94 over the location of valve 66 so that a toothpick, paper clip, or the like can be passed through the fabric 90 to open valve 66 if it should be necessary to reduce the inflation pressure within ball 92. The tennis ball 92 can be pressurized by placing the ball 92 into any of a number of pressurizable containers presently available for shipping and/or storing tennis balls under pressure.

Figures 16 through 22 of Hoffmann shown the details of the valve 66 as it is incorporated as an integral molded valve in the molded rubber shell 12' of the tennis ball. The valve 66 is in the form of an inwardly projecting, flattened tubular nipple 68, having rounded edges (see Figures 21 and 22) and flat sides 70 and 72 which are separated by an internal cavity 74. The cavity 74 becomes bell-shaped as it approaches and opens to the exterior of the ball's rubber shell 12'. At its inner extremity, the nipple 68 is initially molded with a solid closed end, which is lanced through with a sharp blade, leaving a slit 76 that is normally held closed by the elasticity of the rubber but which can be forceably spread apart, as when the air pressure in the cavity 74 is greater than the pressure inside the ball.

The appellant argues (brief, pp. 7-10) that the tennis ball of Hoffman is not implantable as set forth in either (1) the preamble of independent claim 1, which recites "[a]n implantable balloon," or (2) the preamble of claim 11, which recites "[a] self-sealing medical balloon of unitary construction, implantable in a human body."

The examiner's response to this argument (answer, pp. 4-5) is that "the balloon [i.e., tennis ball] of Hoffman is capable of being implanted." It is the examiner's view that the term "implantable" is an extraordinarily broad recitation that can be met by implanting Hoffman's tennis ball in the ground or in a pressurized container as taught by Hoffman. The examiner also takes the position that "it is not inconceivable that a balloon/ball of the size disclosed by Hoffman could not [sic] be implanted in the human body."

Whether to treat a preamble as a limitation is a determination resolved only on review of the entire record to gain an understanding of what the inventor actually invented and intended to encompass by the claim. See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). No litmus test defines when a preamble limits claim scope. Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). On the one hand, a preamble is a claim limitation if it recites essential structure

or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). On the other hand, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Where the inventor uses the claim preamble to recite structural limitations of his claimed invention, the USPTO and the courts give effect to that usage. Id.; Corning Glass Works, supra; Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

We agree with the appellant that the term "implantable" is a limitation of the claims under appeal. The specification is replete with references to the invention as an "implantable" balloon, including the title of the application, the abstract, and the background of the invention. Our analysis shows that the inventor considered that the "implantable" preamble language represented an important characteristic of the claimed invention. We therefore reach the conclusion that the preamble language relating to "implantable" does not state a purpose or an intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention that is properly construed as a limitation of the claim itself.

We understand the term "implantable" as used in the claims under appeal as meaning<sup>3</sup> "capable of being implanted in the living body." As such, the limitation "implantable" is not met by implanting Hoffman's tennis ball in the ground or in a pressurized container. In addition, there is no evidence before us that the tennis ball of Hoffman is capable of being implanted in the human body.<sup>4</sup> In that regard, we note that the fabric covering of Hoffmann's tennis ball is not disclosed as being biocompatible. Thus, it is our view that the tennis ball of Hoffman is not capable of being implanted in the human body.

For the reasons set forth above, the decision of the examiner to reject claims 1 and 11, and claims 2-9, 12, 13 and 16 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

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<sup>3</sup> Source: Merriam-Webster's Medical Desk Dictionary, Revised Edition® 2002.

<sup>4</sup> In that regard, the examiner's assertion alone that the tennis ball of Hoffman is capable of being implanted in the human body is not evidence.

**The obviousness rejection**

We have reviewed the patent to Copenhaver applied in this rejection but find nothing therein that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified the tennis ball of Hoffman to be capable of being implanted in the human body. Accordingly, the decision of the examiner to reject dependent claims 10 and 17 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-9, 11-13 and 16 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 10 and 17 under 35 U.S.C. § 103 is reversed.

REVERSED

  
JOHN P. McQUADE  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

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